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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,790	07/26/2005	Hartmut Geiger	056982/53	8490
31013 7590 08/15/2008 KRAMER LEVIN NAFTALIS & FRANKEL LLP INTELLECTUAL PROPERTY DEPARTMENT 1177 AVENUE OF THE AMERICAS NEW YORK, NY 10036				
EXAMINER				
BURCH, MELODY M				
ART UNIT		PAPER NUMBER		
3683				
NOTIFICATION DATE		DELIVERY MODE		
08/15/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

klpatent@kramerlevin.com

### Office Action Summary

**Application No.**

10/525,790

**Applicant(s)**

GEIGER ET AL.

**Examiner**

Melody M. Burch

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**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 February 2005 and 05 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 8-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 11-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-22 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 2/28/05
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election with traverse of Species I in the reply filed on 5/5/08 is acknowledged. The traversal is on the ground(s) that the PCT authorized officer found that there is no lack of unity and also on the ground that the embodiments are non-obvious variants. This is not found persuasive because the decisions of the PCT authorized officer may be considered as persuasive but are not mandatory authority with respect to prosecution of the US patent application. With regards to the non-obvious variants, Examiner maintains that different embodiments can be considered as different species. In this case the various species set forth in the election requirement have distinct structures warranting an election.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 8-10 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 5/5/08.

***Priority***

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-7, 11-15, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by JP-200287040 (JP'040).

Re: claim 1. JP'040 shows in figure 1 a partly closed air-suspension system for a vehicle, the system comprising at least one first component 25 in communication with atmosphere, the at least one first component being constructed and arranged exclusively for intake of air from atmosphere, and at least one second component 17 in communication with atmosphere, the at least one second component being constructed and arranged exclusively for venting of compressed air to atmosphere.

Re: claims 2-4. JP'040 shows in figure 1 wherein the at least one second component 17 includes at least one valve device as shown.

Re: claim 5. JP'040 shows in figure 1 the system further comprising a compressed air delivery system 1 having an intake side shown on the side near element 21 and an outlet side shown on the side near element 23, and wherein the at least one second component 27 is disposed on the outlet side of the compressed air delivery device.

Re: claim 6. JP'040 shows in figure 1 wherein the at least one second component includes at least one valve device 17 having an inlet port shown below the end of the lead line of number 17 and the compressed air delivery device 1 includes an outlet port on the outlet side shown in the area of element 23, the outlet port being constructed and arranged to permit delivered air to flow out, the outlet port being in

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communication with the inlet port of the at least one valve device via the intervening conduit as shown.

Re: claim 7. JP'040 shows in figure 1 the system comprising an air dryer 3 disposed on the outlet side of the compressed air delivery device 1.

Re: claims 11-14. JP'040 shows in figure 1 wherein the at least one first component 25 has a first port or bottom port for communication with the atmosphere and the at least one second component 17 has a second port shown above the end of the lead line of number 17 separated from the first port for communication with atmosphere.

Re: claim 15. JP'040 shows in figure 1 wherein the at least one second component includes at least one valve device 17 and the air dryer 3 includes an air dryer inlet port on the left side and an air dryer outlet port on the right side of element 3, the air dryer inlet port and the air dryer outlet port being in communication with the at least one valve device by way of the connecting conduits and whereby air flows through the air dryer from the air dryer inlet port to the air dryer outlet port.

Re: claim 22. JP'040 shows in figure 1 wherein the at least one valve device 17 is a part of a combined air discharge/dryer device 3, 17 including at least one air dryer 3.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 13, 14, and 16-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP'040 in view of US Patent 3519011 to Pennanen.

Re: claims 13, 14, 20 and 21. JP'040 is silent with regards to the at least one valve device being a directional control valve having at least two valve positions, particularly a normal fluid passing position and one fluid venting position.

Pennanen shows in figures 2 and 3 the limitation of a at least one valve device or the "replenish and relief valve" being constructed as a directional control valve having at least two valve positions, particularly a normal fluid passing position as shown in figure 3 and a fluid venting position as taught in figure 2.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the valve device of JP'040 to have been a directional control valve having a normal fluid passing position and a fluid venting position, as taught by Pennanen, in order to provide a means of preventing system overpressurization.

Re: claim 16. JP'040 is silent with regards to the at least one valve including inlet and outlet ports and a vent port and the at least one valve device permits a compressed air flow with a large passage cross section from the inlet port to the outlet port and shuts off venting through the vent port when the at least one valve device is in the normal fluid passing position.

Pennanen shows in figures 2 and 3 an at least one valve or "replenish and relief valve" including inlet 11 and outlet 14 ports and a vent port 24 and the at least one valve

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device permits a compressed air flow with a large passage cross section from the inlet port in the area of the end of the lead line of 11 to the outlet port and shuts off venting through the vent port when the at least one valve device is in the normal fluid passing position as shown in figure 3.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the at least one valve device of JP'040 to have been arranged to satisfy the above limitation, as taught by Pennanen, in order to provide a means of controlling flow in a certain manner to achieve desired suspension characteristics depending on the particular application.

Re: claims 17-19. JP'040 is silent with regards to the at least one valve including inlet and outlet ports and a vent port and the at least one valve device permitting a throttled compressed-air flow with relatively small passage cross section from the inlet port to the outlet port and but shows permitting venting of the compressed air that has flowed through the air dryer through the vent port when said at least one valve device is in said fluid venting position particularly when the recirculated fluid is vented at element 17.

Pennanen shows in figures 2 and 3 an at least one valve or "replenish and relief valve" including inlet 11 and outlet 14 ports and a vent port 24 and the at least one valve device permitting a throttled compressed-air flow with relatively small passage cross section as shown below the end of the lead line of number 12 shown in figure 2 from the inlet port to the outlet port.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the at least one valve device of JP'040 to have been arranged with the small cross section, as taught by Pennanen, in order to provide a means of controlling flow in a certain manner to achieve desired suspension characteristics depending on the particular application.

With regards to claim 19, Examiner notes that in the absence of an explanation of criticality, the holding in *Garnder v. TEC Systems Inc.* serves as precedent. In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patent Application 2005/0212225 to Suzuki et al. and US Patents: 4881753 to Shima et al., 5466007 to Smith teach the use of a first component on an input side of a compressed air delivery device and the second component on the output side of the device with both components having a port that communicates with the atmosphere.

In order to complete the record, it should be noted that no conflict appears to presently exist between the subject matter defined by the instant claims and the subject



matter of the claims of applicant's and/or assignee's copending application nos. 2006/0049606 to Geiger, 2006/0043691 to Geiger or 2004/0188970 to Matern et al. that have been made of record. Accordingly, no double patenting rejection is entered into the instant application. See MPEP 804+ concerning double patenting type of rejections, if necessary. Applicant and/or assignee should maintain this clear line of patentable distinction between the instant claims and the claims of the indicated patent application.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melody M. Burch whose telephone number is 571-272-7114. The examiner can normally be reached on Monday-Friday (6:30 AM-3:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Siconolfi can be reached on 571-272-7124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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mmb

August 8, 2008

/Melody M. Burch/

Primary Examiner, Art Unit 3683